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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/825,565 03/31/97 OYAMA

S 1095.1071/JD

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WASHINGTON DC 20001

EXAMINER

WEINHARDT, R

ART UNIT

PAPER NUMBER

2764

DATE MAILED:

06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/825,565

Applicant(s)
Oyama et al

Examiner
Robert Weinhardt

Group Art Unit
2764



☒ Responsive to communication(s) filed on May 11, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-14 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 5/11/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/825,565 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-4, 8-9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. in view of Atkins and the Money Laundering Alert article, "Fed's Examiners Get Roadmap to KYC Weaknesses in Banks" (hereinafter MLA).

As stated previously, Weiss et al. teach a computerized system for opening a new account including a bank account such as a savings and/or checking account wherein a customer processing means is provided for applying for a new bank account by supplying the first bank system with information concerning the customer's financial and/or investment situation and information necessary to open the new account. Weiss further teaches first bank processing means for opening the new account based on a confirmation message and that the new account can be opened by an existing customer. See the abstract, fig. 1, col. 4 line 60 to col. 5 line 14, col 7 line 50 to col, 8 line 49, col. 9 line 4 to col. 10 line 22, col. 12 line 63 to col. 13 line 14, col. 14 lines 18-61, col. 15 lines 35-45, col. 16 lines 4-18, col. 19 lines 21-28, col. 20 lines 18-35 of Weiss.

While Weiss does not explicitly teach that the "customer's financial and/or investment situation" includes existing bank accounts at other banks, those of ordinary skill in the art would have recognized that in order to accurately portray a customer's financial and/or investment situation, accounts from other banks would have been input into the system of Weiss. Thus, Weiss is seen to impliedly teach that collection of existing account information including accounts at other banks.

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Weiss does not explicitly teach that the first bank processing means requests a second bank processing means to make a confirmation of an existing bank account. However, Weiss does at least teach that the first bank processing means performs a credit check on the applicant including contacting a credit bureau through the use of a modem or other communication equipment. Further, Atkins specifically teaches that when opening an account in a computerized system, other banks and financial service institutions may communicate with the system in order to verify asset or liability holdings or to transfer asset or liability holdings. See the abstract, fig. 2 and col. 9 lines 31-35 of Atkins. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of Weiss to include the contacting of other banks to verify and/or transfer asset or liability holdings of an applicant for an account for the obvious advantage of increased security when opening the new account.

With respect to the use of an open network, Weiss specifically teaches that the customers can access the bank processing means remotely via their PC's. As is well known in the art, and Official Notice is taken thereof, common means for connecting PC's to business services include open networks, e.g. the Internet. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of Weiss to include an open network connection for the customers' PC's already taught by Weiss for the obvious advantage of employing a readily available, off-the-shelf means of connection. With respect to the use of an "inter-bank" network, as this broad term

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merely calls for interconnecting the various bank processing means, this is seen to be provided in Weiss as noted above with respect to the verification and/or transfer of an applicant's holdings.

Concerning the content of the existing account information, as the second bank needs to be identified and contacted for verification and possible transfer of a particular customer's holdings, the existing account information must include a bank identification code of the second bank, an account number of the existing bank account and a password.

The MLA article clearly teaches that banks opening new accounts should get bank references from customers and those banks should be asked about the customer's banking activity in accordance with Federal Reserve policy to "Know Your Customer". See the entire MLA article. In addition to the verification in Atkins discussed in the prior Office actions, Weiss also teaches the use of "CHEX" screening, which is known to check information from other financial institutions (col. 12 line 63 to col. 13 line 4 of Weiss). Since following this Federal Reserve policy would have helped decrease money laundering by customer identification and since Weiss and Atkins teach verification, it would have been obvious to those of ordinary skill in the art to modify the teachings of Weiss and Atkins to include asking for and checking customer bank references as taught by MLA at least for the advantage of reducing money laundering.

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Applicant has described the "present invention" as one that "enables a customer to open a bank account online, without visiting the bank's offices or registering his/her data with a special certifying authority". However, the claims merely require that the authentication is "based on" the confirmation from the second bank. This does not exclude other forms of authorization or the submission of other proof of identity.

With respect to Atkins, applicant argues that Atkins communicates with other institutions to provide financial management services and does not "authenticate a new customer who wishes to have his/her account opened". This is an overly narrow view of the teachings of Atkins. As quoted by applicant, Atkins teaches that "other banks, financial service institutions and insurance companies 246 may communicate with the HOPE account's system in order to transfer asset and liability holdings or verify asset of liability holdings". This is performed in response to a customer wishing to open a HOPE account in Atkins. While the other banks do provide financial management services, they also clearly "verify asset or liability holdings". Applicant argues that verifying holdings is not the same as "confirming the validity of an existing bank account", but at least implicit in the verification of asset or liability holdings at a bank or financial service institutions performed by Atkins is the confirmation of the validity of the account identified by the customer when opening the HOPE account. Holdings could not be verified if the bank account given is not also valid. Again, note that the claimed authentication is "based on" the confirmation of validity. Further, note that second bank

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as claimed does not only confirm just the validity of the existing bank account. The claims are broad enough that the second bank can provide other information.

Concerning Weiss in view of Atkins, applicant appears to argue that a certifying authority must be used, but this is not understood in light of the teachings of Atkins where the banks and financial institutions themselves are used.

Applicant further argues that none of the applied prior art teaches "wherein the first bank processing means authenticates the customer based on the confirmation". The verification in Atkins at least implicitly provides this function since verifying existing holdings at least indirectly proves the identity of the customer as discussed above. Moreover, in light of the MLA article, checking bank references provides compliance with "Know Your Customer" policy directed at establishing identity and preventing money laundering.

Concerning claim 9, applicant argues the limitations of "sending, along with account application information necessary for opening a bank account in the first bank system, existing account information pertaining to the existing bank account owned by the customer in order to allow the first bank to request the second bank to authenticate the customer's identity". However, the arguments presented above apply for this limitation as well. In contacting the banks and financial institutions in Atkins for verification of holdings, existing account information and customer identification (information necessary for opening an account) must have been transmitted. It would

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not have been enough to merely verify that an account exists at the second institution in Atkins, it would have had to have been established that the person applying for the account actually owns the account at the second institution to properly open the account. Similarly, in the MLA article, merely finding an account number at another institution tells you nothing about the customer unless the account number is associated with the identity of the customer.

Similarly, with respect to claims 12-14 applicant argues the limitation of "requesting the second bank to authenticate the customer based on the existing account information contained in the third information", but the above arguments apply to this limitation as well. Finally, concerning the network details in claims 2-7, these have been addressed previously.

4. Claims 5-7, 10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. in view of Atkins and the Money Laundering Alert article, "Fed's Examiners Get Roadmap to KYC Weaknesses in Banks" (hereinafter MLA) as applied to claims 1-4, 8-9, 11 above, and further in view of Micali as set forth in the Office action mailed 6/28/99.

With regard to this grounds of rejection, applicant relies on the arguments presented concerning Weiss and Atkins, which have been treated above. The

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inclusion of the teachings of Micali provide the anonymity as set forth previously.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"SCAN OnLine Defines New Era in the Fight Against Check Fraud" teaches new account verification. "How Institutions Can Prepare For "Know Your Customer" Regs" teaches verification by contacting the person's previous financial institution.

"Compliance Issues in Cyberspace" teaches Internet bank's obligations regarding "Know Your Customer" standards and the Bank Secrecy Act. "Community Group Keeps Watchful Eye on Goldome" teaches a bank requiring a signature verification from another financial institution.

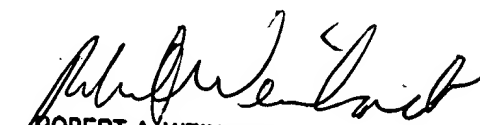
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM. The examiner can also be reached at the e-mail address:
robert.weinhardt@uspto.gov

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768. Facsimile transmissions to this Group may be directed to (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

June 18, 2000


ROBERT A. WEINHARDT
PRIMARY EXAMINER